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10/590,512	02/29/2008	Takehiro Matsumoto	47487-0003 (230337)	1013
55694 7590 02/28/2011 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209			EXAMINER WILLIAMS, LELA	
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## **DETAILED ACTION**

### **Response to Arguments**

Applicant's arguments filed February 14, 2011 have been fully considered but they are not persuasive.

Prior to addressing applicants' arguments, it is noted that with respect to the limitations added to claims 1, 9, and 15, namely, the beverage “having a decreased odor of maca” and “and wherein the distilled liquor and the acetic acid, in combination, decreases an odor of maca”, these limitations would be met by Suntory in view of Herraiz given that the combination of Suntory in combination with Herraiz is identical to that of the presently claimed method, the combination of the references would naturally decrease the odor of maca extract contained in the beverage.

Applicant argues that “Herraiz does not identify either the type of Pisco or the source of Pisco used”; however, given that the reference disclosed an “Analysis of Wine Distillates Made from Muscat Grapes (Pisco)...” and that “Pisco is a common drink...which is obtained by distillation of wine made from Muscat grapes.” It is reasonable to conclude the type of Pisco used in the reference is made from Muscat grapes. Applicants provide EXHIBIT I to show that “pisco” is a broad term and may not use Muscat grapes, however, as previously stated, Herraiz explicitly states the use of Muscat grapes.

Applicant states that a “skilled artisan has no way of knowing where or how to acquire the Pisco analyzed by Herraiz”; however that does not detract from the teaching set forth in the reference. Even if the skilled artisan could not find the Pisco of Herraiz, the artisan would have the knowledge that it was obtained by distillation of wine made from Muscat grapes, as such,

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given that the said wine was made from Muscat grapes, as is the present invention, it would intrinsically possess the desired properties as presently claimed. Therefore, given that Herraiz discloses a wine made from Muscat grapes and shows that it possesses an acetic acid amount as that presently claimed, it would have been obvious to one of ordinary skill in the art to use said grapes in the liquor of Suntory, in order to produce a "high quality" beverage. Furthermore, as set forth in MPEP 2121, when the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. In *re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See also MPEP § 716.07." It is noted that MPEP 2121.01 further states that a reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill on the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention", In *re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). Donohue further states that it "is not, however, necessary that an invention described in a publication shall have actually been made in order to satisfy the enablement requirement and citing In *re Samour*, 571 F.2d 559, 197 USPQ 1, further states "[W]hether or not the claimed invention has been made previously is not essential to the determination that a method of preparing it would have been known by, or would have been obvious to, one of ordinary skill in the art".

Regarding Applicants argument that the prior art is completely devoid of any suggestion that the distilled liquor and acetic acid in combination mask an odor of maca, given that Suntory in view of Herraiz disclosure is identical to the presently claimed, the combination of the

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references would naturally decrease the odor of maca extract contained in the beverage. In response to applicant's argument that there is no suggestion of the combination masking an odor of maca, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Regarding Applicants remark to there being no reason "to choose the unidentified "pisco" of Herraiz over a different liquor", Herraiz teaches that wines made from Muscat grapes are considered high-quality products, therefore, one skilled in the art would have been motivated to use said grapes in efforts to produce a high quality beverage. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The rejection is not based on hindsight but rather proper motivation to combine, i.e., the use of Muscat grapes to produce quality wine, found in the reference (Herraiz) itself.

Regarding the method of claim 9, which Applicant states is not disclosed by the prior art of record, Suntory in view of Herraiz discloses a distilled liquor product made from Muscat grapes with an extract of maca, wherein the acetic acid content is 100 mg/l (100ppm) of absolute ethanol, contains lemon and lime juice, and rose hip extract. Therefore, given the combination of

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Suntory in view of Herraiz is identical to the presently claimed method, the combination of the references would naturally decrease the odor of maca extract contained in the beverage.

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, Herraiz clearly teaches wines made from Muscat grapes are "considered a high-quality product and a factor of important economical repercussion." (p. 1540, col. 2).

Further regarding applicant's remarks that the Office has not specified what aspect of modified Suntory would show "high quality"; Herraiz discloses that Pisco made from Muscat produce high quality wines which can be attributed to the high content level of volatile terpenoids which are well understood in the art to contribute to the organoleptic properties of the wine (p. 1543, col. 1). Therefore, it would have been obvious to one of ordinary skill in the art to uses said grapes in the product of Suntory in efforts to produce a wine having a high content level of volatile terpenoids, thereby producing a high quality wine product.

Regarding Applicants remarks to unexpected results, given that Suntory in view of Herraiz discloses a distilled liquor product made from Muscat grapes with an extract of maca, wherein the acetic acid content is 100 mg/l (100ppm) of absolute ethanol, and contains lemon

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and lime juice, and rose hip extract, the combination of the references would naturally decrease the odor of maca extract contained in the beverage. Thereby producing expected results.

/LELA S. WILLIAMS/

Examiner, Art Unit 1789

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787